



Doc Code: AP.PRE.REQ

PTO/SB/33 (07-05)

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PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional) CSCO-96941	
I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)] on <u>03/27/2006</u> Signature <u>Shannon Carmo</u>		Application Number 09/752,607	Filed 12/27/2000
		First Named Inventor William WILLIAMS	
Typed or printed name <u>Shannon Carmo</u>		Art Unit 2161	Examiner NGUYEN, Cindy

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

applicant/inventor.

assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

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03/27/2006

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.
Submit multiple forms if more than one signature is required, see below*.

*Total of 1 forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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REMARKS ACCOMPANYING PRE-APPEAL BRIEF REQUEST FOR REVIEW

In response to the Final Office Action dated November 25, 2005, Applicant respectfully requests a review of the final rejection in the above-identified application. Applicant respectfully submits that the Examiner's rejections of the Claims are improper as essential elements needed for establishing proper *prima facie* rejections are missing (e.g., the teaching of all of the recited claim limitations). Independent Claims 1, 12, 14 and 20 stand rejected under 35 U.S.C. §103(a) as being unpatentable over United States Patent 6,505,216 by Schutzman et al., hereinafter referred to as the "Schutzman" reference, in view of United States Patent 5,613,060 by Britton et al., hereinafter referred to as the "Britton" reference. Independent Claims 8, 17 and 23 stand rejected under 35 U.S.C. §103(a) as being unpatentable over United States Patent 6,085,298 by Ohran, hereinafter referred to as the "Ohran" reference, in view of Britton. While only certain ground for rejection are addressed in this Pre-Appeal Brief, this should not be construed that Applicant agrees with the other grounds for rejection presented in the Final Office Action.

Claim Limitations Having To Do With Transmitting a Plurality of Asynchronous Streams Are Not

Met By The Cited References

Independent Claim 1 sets forth a method of archiving a database comprising: "transmitting a plurality of asynchronous streams to a backup database", (emphasis added). Independent Claims 12, 14 and 20 recite similar limitations.

Applicant respectfully asserts that the combination of Schutzman and Britton fails to teach or suggest the present invention as claimed because the combination of Schutzman and Britton does not satisfy the requirements of a *prima facie* case of obviousness. In order to establish a *prima facie* case of obviousness, the prior art must suggest the desirability of the claimed invention (MPEP 2142). In particular, "if the proposed modification or combination of the prior art would change the principle

of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious" (emphasis added) (MPEP 2143.01; *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959)). Moreover, "[i]f the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed amendment" (emphasis added) (MPEP 2143.01; *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984)).

Applicant understands Schutzman to teach a method and apparatus for backing-up and restoring files using multiple trails. In particular, Schutzman Applicant respectfully asserts that that the multiple trails are operable to backup the files synchronously. With reference to Figure 3 of Schutzman, the multi-trail backup system of Schutzman is explicitly shown. In particular, the multi-trail backup system of Schutzman "can transfer different data portions 120-1 through 120-3 associated with the same file 120 between respective storage devices (e.g., disks), 116-1, 116-2 and 116-K and respective backup devices (e.g., tapes), 114-1, 114-2 and 114-L over the same time period" (emphasis added, col. 14, lines 24-28). Applicant respectfully submits that such a teaching discloses the use of synchronized transmission of the different trails. In other words, Applicant respectfully asserts that the different trails are transmitted to backup devices synchronously, as they are transmitted over the same period of time.

In contrast, embodiments of the claimed invention are directed towards a method of archiving comprising: "transmitting a plurality of asynchronous streams to a backup database", as claimed (emphasis added). In particular, "a first asynchronous stream of said plurality of asynchronous streams is transmitted asynchronously with respect to a second asynchronous stream of said plurality of asynchronous streams", as claimed.

Applicant respectfully asserts that Schutzman in particular does not teach, disclose, or suggest a method of archiving a database including “transmitting a plurality of asynchronous streams to a backup database”, as claimed (emphasis added). In particular, the principle of operation of Schutzman is to transmit streams synchronously. Applicant respectfully asserts that modifying Schutzman to transmit asynchronous streams would render Schutzman inoperable for its intended purpose. Accordingly, by teaching that the data portions are transmitted to the backup devices over the same time period, Applicant understands that the update log records of Schutzman are transmitted synchronously, and that Schutzman thus teaches away from the present invention as claimed.

Moreover, the combination of Schutzman and Britton fails to teach or suggest this claim limitation because the combination of Schutzman and Britton fails to teach or suggest the present invention as claimed because the combination of Schutzman and Britton does not satisfy the requirements of a *prima facie* case of obviousness. Britton, alone or in combination with Schutzman, does not teach, disclose, or suggest transmitting a plurality of asynchronous streams to a backup database, as claimed. As described above, Schutzman teaches a system where multiple streams are synchronously transferred between corresponding pairs of storage devices and backup devices such that a single stream synchronously transmits a data portion between a different storage device and a different backup device. Accordingly, by teaching that the data portions are transmitted to the backup devices synchronously, Applicant respectfully asserts that Schutzman thus teaches away from the combination with Britton, as asserted by the Examiner, because such a combination would render Schutzman inoperable for its intended purpose.

Accordingly, the aforementioned limitations are not taught or suggested by Schutzman and Britton and thus an essential element needed for a *prima facie* rejection based on the cited references is not present. Examiner is also referred to arguments of record which can be found at page 12, line

4, through page 19, line 8, of the Amendment and Response mailed on August 19, 2005, for further support of the above discussion.

Claim Limitations Having To Do With Rendering the Automatic Recovery Process Are Not Met By

The Cited References

Independent Claim 8 sets forth a method of performing automatic recoveries on an archived database comprising: "wherein the automatic recovery process is run by a program automatically in the background without requiring initiation and is run independent of a complete system backup," (emphasis added). Independent Claims 17 and 23 recite similar limitations.

Applicant understands Ohran to teach a system and method for backing up a primary storage device to a backup storage device (col. 5, lines 24-27). Specifically, Ohran teaches a backup system that determines the difference between data located on the primary storage device and the backup storage device, and backs up only the changed data (col. 5, lines 30-40). In particular, this determination is performed in conjunction with performing a system backup. With reference to Figure 10 of Ohran, at steps 214 and 216 it is identified whether a backup is being initiated (col. 29, lines 41-43). Ohran describes in detail various modes for initiating a backup (col. 20, lines 20-61). In particular, Applicant respectfully asserts that Ohran teaches that a backup must be initiated, and that the processing as performed at backup system processing block 60 must be performed in conjunction with a complete backup.

In contrast, embodiments of the claimed invention are directed towards "wherein the automatic recovery process is run by a program automatically in the background without requiring initiation and is run independent of a complete system backup", as claimed. In particular, the automatic recovery process is not a system backup, as described in the Ohran reference.

Moreover, the combination of Ohran and Britton fails to teach or suggest the present invention as claimed because Britton does not overcome the shortcomings of Ohran. Britton, alone or in combination with Ohran, does not show or suggest a method of performing automatic recoveries by a program automatically in the background without requiring initiation and that is run independent of a complete system backup, as claimed. Britton teaches that a manual recovery administrative request is used to repair sync point failures. In contrast, as described above, embodiments of the claimed invention are directed towards a method of performing automatic recoveries on an archived database, as claimed. Applicant respectfully asserts that the recovery administrative request as described in the Britton reference requires initiation by a user, thereby teaching away from the invention as claimed.

Accordingly, the aforementioned limitations are not taught or suggested by Schutzman and Britton and thus an essential element needed for a *prima facie* rejection based on the cited references is not present. Examiner is also referred to arguments of record which can be found at page 19, line 10, through page 24, line 21, of the Amendment and Response mailed on August 19, 2005, for further support of the above discussion.

In summary, Applicant respectfully submits that the Examiner's rejections of the Claims are improper as key limitations of independent Claims 1, 8, 12, 14, 17, 20 and 23 are not met by the cited references. Therefore, Applicant respectfully submits that the rejections of Claims 1, 3-14, 16-20 and 22-24 under 35 U.S.C. §103(a) as being unpatentable are improper and should be reversed.